

**REMARKS**

In the October 20, 2003 Office Action, the Examiner noted that claims 1-18 were pending in the application, but claims 4-8, 12-16 and 18 had been withdrawn from consideration and claims 1-3, 9-11 and 17 were rejected under the second paragraph of 35 U.S.C. §112 and under 35 U.S.C. § 103(a). In rejecting the claims, U.S. Patents 6,546,416 to Kirsch and 5,765,033 to Miloslavsky (References A and B, respectively) were cited. The Examiner's rejections are traversed below.

**Examiner Interview**

The undersigned wishes to thank the Examiner for the opportunity to discuss the rejections during the telephonic Examiner Interview on March 23, 2004. In accordance with the discussion regarding the document submitted in the previous Information Disclosure Statements that has not yet been considered, it is respectfully requested that the form PTO-1449 attached to the Information Disclosure Statement filed by Certificate of Mail on August 1, 2003 be returned to the undersigned with the Examiner's initials indicating that the printed web page has been considered. As discussed during the Examiner Interview, Applicant is not requesting that the book mentioned on the printed web page be considered.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

On pages 2-3 of the Office Action, claims 1-3, 9-11 and 17 were rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness, because it was unclear what was extracted from the received email. As discussed during the Examiner Interview, the claims are directed to a system that enables users to reduce the amount of spam received by providing a mechanism for processing email differently based on destination address. Submitted herewith is an Information Disclosure Statement for printed web pages that describe a service from Yahoo! that appears to be within or close to the scope of the claims. The Yahoo! web pages are not being submitted as prior art, since there is no indication that the service existed prior to filing of the subject patent application.

As discussed at the Examiner Interview and in the Yahoo! web pages, the present invention enables email to be processed based on the destination address. This enables similar (or dissimilar) email addresses to be used by a single person at a single Internet Service Provider (ISP) to be processed in different ways. Unlike the conventional spam blocking methods that process email based on content or sender addresses, the present invention enables users to take control of how their email is processed based on who uses a specific

email address to send them email. For example one or more email address could be given to commercial organizations, one or more other addresses given to friends and relatives and one or more other email addresses given to business associates.

During the March 23, 2004 Examiner Interview, the Examiner requested an explanation of how claim 1 corresponds to the disclosed embodiment illustrated in Fig. 1A. As described at page 12, line 13 to page 13, line 7, mail extracting unit 3 in Fig. 1A extracts a mail address indicating a destination for received email, while processing content storing unit 2 stores pairs of addresses and corresponding processing methods, as represented by table 2A in Fig. 1B. Thus, in the embodiment illustrated in Fig. 1A, the processing content storing unit 2 corresponds to the storing unit recited in claim 1. Although there is no box labeled "extracting" in Fig. 1A, the extracting operation recited as being performed by the mail address extracting unit in claim 1 could be performed in mail accepting unit 3 prior to or as part of the box labeled "MATCHING". The operations, "matching" (claim 1, line 6) and "processing" (claim 1, line 8), recited as being performed by the mail processing unit match labels of boxes inside the mail accepting unit 3 in Fig. 1A.

The Examiner is respectfully requested to approve the change to Fig. 1A to show that information passes from processing content storing unit 2 to mail accepting unit 3, so that the processing method indicated in the table stored in processing content storing unit 2 can be performed in the block labeled "PROCESSING" in mail accepting unit 3.

If there are any further questions regarding the clarity of language in the claims, the Examiner is respectfully requested to contact the undersigned by telephone to arrange another Examiner Interview to resolve any remaining issues.

#### **Rejections under 35 U.S.C. § 103(a)**

On page 3 of the Office Action, claims 1-3, 9-11 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kirsch in view of Miloslavsky. As discussed in the Amendment filed by certificate of mail on August 1, 2003, Kirsch only uses the origin or source address of email in determining how email will be handled. Although Miloslavsky discloses at column 4, line 34 that the addresses of both the sender and the recipient are extracted as part of the relevant information, the only subsequent use of the word "recipient" is at column 5, line 47 in regard to a reply message where the recipient is the sender of the original email. One reason that the system taught by Miloslavsky does not consider the recipient addressed to be very important is that in the disclosed embodiment the system is used for routing email to support personnel and "there is no guarantee that the intended recipient is available to reply to the email"(column 2, line 6-8).

For the reasons set forth in the August 1, 2003 Amendment and discussed during the Examiner Interview, it is submitted that claims 1-3, 9-11 and 17 patentably distinguish over Kirsch in view of Miloslavsky. Thus, it is submitted that claims 1-3, 9-11 and 17 are in a condition suitable for allowance.

#### Entry of Amendment

It is submitted that the changes to Fig. 1A requested to be approved by the Examiner do not introduce any "new matter", since the change is consistent with the description on pages 12-13 of the embodiment illustrated in Fig. 1A. Furthermore, it is submitted that no new search should be required, since the claims were not amended. Therefore, entry of this Amendment and reconsideration of the claims are earnestly solicited.

#### Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-3, 9-11 and 17 are in a condition suitable for allowance. A Notice of Appeal is submitted herewith to provide two months for reconsideration of the claims and the issuance of a Notice of Allowance, before further action is required on behalf of the Applicant.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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